

**REMARKS**

Claims 5 to 8 have been amended by this amendment. No new matter has been added.

Claims 18 to 21 were previously cancelled,

Claims 1-17 and 22-26 are pending in the application.

**Allowable Subject Matter**

The Office Action dated December 10, 2008 states:

“Claims 10, 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 17 is in condition for allowance”

Applicants respectfully submit that claims 23 to 25 are dependent on allowable claim 17.

Thus, Applicants wish to inquire if dependent claims 23 to 25 are allowable in addition to claim 17.

Applicants thank the Examiner for the recognition of allowability of claim 10.

**Claim Rejections – 35 USC § 112**

Claims 5-9, and 26 are rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reason as listed in the Office Action of December 10, 2008.

Of the claims rejected, claim 5 is independent, with the remaining claims dependent thereon.

Claims 5 to 8 have been amended to delete the term “rotational”.

Amended claim 5 now recites among other things:

*whereby said channel can be disposed in either a first orientation or in a second orientation relative to said support wall for altering positions of said channel relative to said needle cannula.*

Applicants submit that these amendments fully address this rejection.

**Claims Rejections – 35 USC § 103**

Claims 1-9, 11-16, 19, 22, 24, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,632,732 to Szabo et al. (“Szabo”) in view of US Patent No. 5,509,907 to Bevilacqua (“Bevilacqua”).

These rejections are respectfully traversed.

Of the claims rejected, claim 19 was previously cancelled, and claims 22, 24 and 25 are dependent on allowable claim 17. Claims 1 and 5 are independent, with the remaining claims dependent thereon.

Claim 1 is directed to a safety needle assembly and recites, among other things:

*said shield comprising at least one support wall, and a channel mounted to said support wall, said channel having a top wall and opposed first and second sidewalls extending from said top wall, and at least one resiliently deflectable cannula finger lock projecting from said first sidewall angularly toward said top wall,*

*wherein said channel can be selectively mounted to said support wall in one of a plurality of orientations in relation to one another.*

Claim 5 is directed to a safety needle assembly and recites, among other things:

*said shield comprising at least one support wall, and a channel mounted to said support wall, said channel having a top wall and opposed first and second sidewalls extending from said top wall, and at least one resiliently deflectable cannula finger lock,*

*wherein said top wall of said channel comprises mounting structure for mounting said channel to said support wall, whereby said channel can be disposed in either a first orientation or in a second orientation relative to said support wall for altering positions of said channel relative to said needle cannula.*

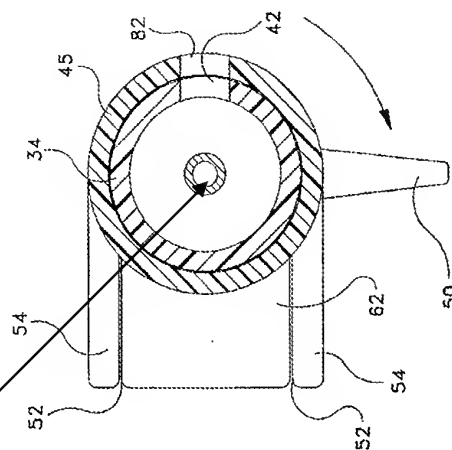
Applicants agree with the Examiner that Szabo fails to disclose teach or suggest at least the claimed features of at least one resiliently deflectable cannula finger lock.

The Examiner takes the position in that it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to modify the shield of Szabo to include a cannula finger lock, as taught by Bevilacqua.

In the absence of hindsight, one skilled in the art would not have been motivated by Szabo to look at or for inclusion of at least one resiliently deflectable cannula finger lock, and thus would have no reason to look to the Bevilacqua reference.

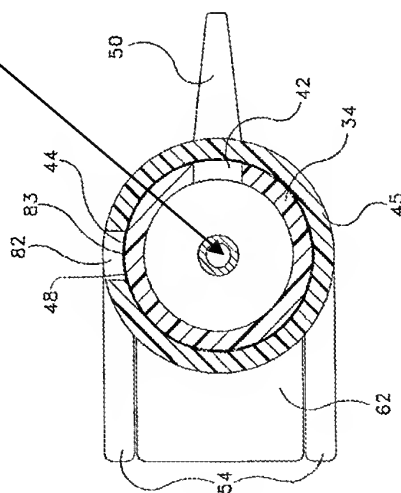
Szabo discloses a cylindrical shield and coaxially aligned latch, in which neither the shield (34) nor latch (45) engages the needle cannula (See Figs 7 and 8 reproduced below, emphasis added).

**FIG.8**



**FIG. 7**

Cannula



Thus Szabo device relies on the annular rotation of latch (45) relative to shield (34) to cause a misalignment of elongate slots (82) and (42) in order to trap the cannula within shield (34).

Therefore one skilled in art would have absolutely no motivation to add an additional “redundant” cannula retention feature such as at least one resiliently deflectable cannula finger lock to trap the cannula in the shield of Szabo.

The Examiner should also note, according to MPEP §2143.01 Section VI, that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Furthermore, according to MPEP §2143.01 Section V, that if a proposed modification would render the prior art invention modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

A modification of the Szabo shield to have at least one resiliently deflectable cannula finger results in a change in the principle of operation of the shield if not rendering the shield unsatisfactory for its intended purpose.

Szabo discloses several benefits of the shield over the existing art which include for example the ability to reuse the shield and also the ability for the user to readily visually ascertain if the shield is open or closed (hence is the cannula safely shielded) by looking at the alignment of the elongated slots (see Col. 3 lines 8 to 35).

Thus the addition of at least one resiliently deflectable cannula finger to the shield would prevent the reuse of a shield and render the visual indication of shielding moot thereby changing the principle of operation of Szabo.

Bevilacqua was cited for the use of a cannula finger lock. Bevilacqua does not overcome the deficiencies of Szabo as set forth above.

For these reasons, applicants submit that independent claim 1 and dependent claims 2-4 10-16, and independent claim 5 and dependent claims 6-9 and 26, are patentable over the cited references.

**Double Patenting Rejection**

The Examiner rejected claims 1 and 5 under the doctrine of obviousness-type double patenting, as being unpatentable over claims 1 and 6 of U.S. Patent No. 7,220,249.

Applicant will file a Terminal Disclaimer if warranted, upon allowance of the claims, which addresses this rejection.

**Conclusion**

In view of the amendment and remarks herein, applicants submit the claims are patentably distinct over the prior art and allowable in form.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 02-1666.

If the Examiner has any questions or comments relating to the present application, he or she is respectfully invited to contact Applicant's agent at the telephone number set forth below.

Respectfully submitted,

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